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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,827	08/30/2000	Eric Schneider		1226

24226 7590 06/22/2004  
ERIC SCHNEIDER  
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# 258  
UNIVERSITY HEIGHTS, OH 44118

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 06/22/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/650,827

Applicant(s)

SCHNEIDER, ERIC

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is in response to amendment filed 01/03/04, claims 21-40 remain pending.
2. Consideration that this prosecution is handled by the inventor himself (see MPEP §401), this office action is made non-final, providing applicant the opportunity to correct certain deficiencies noted on filed amendment and/or clarify certain issues.
3. Applicant is reminded of 37 CFR 1.530 (e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there MUST also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an *explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper* (see MPEP 2234). There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96; however, with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02, and 2163.06. (“*Applicant should specifically point out the support for any amendments made to the disclosure.*”) (see MPEP § 2163.04).

In this case, it is not clear where in the specification are the following clauses discussed raising the following uncertainties: (i) where is an identifier configured with the capability of being registered, perhaps given the broadest reasonable interpretation, this simply reads generating identifiers to be or that can be registered; (ii) said plurality of registerable naming system are “separate from one another” (e.g. distributed on different machines or modularized, e.g. separately on the same machine), further “are not part of a larger single naming system” (e.g. independent, distinct, not related, or not replicas, not part of a distributed system), and further more, one of the plurality of registerable naming systems is a “global public internet domain name system” (wide-spread, uniform, distributed, etc.) (DNS). Claim clause “providing the requestor with an ability to determine”, will be interpreted as wherein method determines and provides said determination to the user, thereby the user is provided an indication as to whether said generated identifier is available for registration.

4. Applicant is reminded of 2173.05(i) Negative Limitations. Boundaries of the patent protection sought must be set forth definitely, *albeit negatively*, the claim complies with the requirements of 35

U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because *they tended to define the invention in terms of what it was not, rather than pointing out the invention*. Thus, the court observed that the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by *excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent*. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph.

In this case, a specific indication as to where in the specification, “said plurality of said registerable naming system are naming systems separate from one another and are *not* part of a larger single naming system, wherein at least one is a *global public internet* domain name (DNS)” is required.

5. Examiner acknowledges applicant’s right to be his/her own lexicographer (see MPEP 2111), provided the subject matter is disclosed by the specification as filed. However, terminology used inconsistent with accepted meaning, specifically, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, requires *the written description to clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term*. Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “global public internet domain naming system” in claim 1 is used by the claim to mean “one registerable naming system of a plurality of registerable naming system that are separate from one another and not part of a larger single naming system”, while the accepted meaning is “central list of domain name/IP address correspondences distributed throughout the Internet in a hierarchy of authority, typically on a DNS server within close geographic proximity to an user access provider that maps the domain names in your Internet requests or forwards them to other servers in the Internet.” Indication as to where is the term redefined is required.

6. Examiner notes that the construction of language solely with the purpose of exclude the *language* of the teachings of the applied prior art leads to the above scenarios.

The invention provides a method for concurrently registering identifiers across different top-level domains based on WHOIS and DNS technology (not broadly/clearly seen claimed at least on independent claims), thereby most likely the technology, i.e. its functionality and structure are not destroyed, but enhanced with what applicant seeks patent protection. For example subject matter discussed on page 1-15, wherein a determination is made as to whether identifiers, such as telephone numbers are available for registration across domain name system, would provoke further search and/or consideration.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231


or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

  
B. Prieto  
TC 2100  
Patent Examiner  
June 15, 2004